

## REMARKS

Applicants appreciate the detailed examination evidenced by the Final Office Action. Applicants also appreciate the withdrawal of the rejections over U.S. Patent No. 5,918,229 to Davis et al. Claims 3 and 6 have been amended to independent form by including the recitations of Claim 1. Applicants request reconsideration of the Final Rejection of the claims as being premature, and submit that the pending claims are patentable over the cited references for at least the reasons provided below.

### **Final Rejection of the Claims Is Premature**

The Final Office Action states that the final rejection of the claims was caused by "Applicant's Amendments made to the claims where new issues relating to hints that comprise 'an indication of anticipated relationships' was introduced." Applicants note that the MPEP Sec. 706.07(a) states that a "second or any subsequent action on the merits in any application ... should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed." In their response to the first Office Action of May 20, 2004, Applicants amended independent Claims 1, 20, and 21 merely to clarify the meaning of the recited term "hints". In particular, "hints" was clarified to "comprise an indication of anticipated" relationships among files. Applicants submit that these amendments could not have introduced "new issues", and should reasonably have been expected to be have been made, because the originally recited "hints" term must have been initially examined based on the meaning of that term as it is defined by the Specification, which is "an indication of the anticipated use of the data ...". (Specification, page 10, line 28 - page 11, line 1, emphasis added).

Consequently, Applicants submit that the final rejection of the claims based on newly cited art was prematurely issued and request withdrawal of the final rejection.

### **Independent Claims 1, 3, 6, 20, and 21 are Patentable Over Papierniak in View of Shoup**

Claims 1-8, 10-11, 13, and 20-21 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,169,997 to Papierniak et al. ("Papierniak") in view of U.S. Publication 2002/0147734 to Shoup et al. ("Shoup").

Claim 1 recites (emphasis added):

1. (Previously Presented) A method of storing content in a computing network, comprising:  
receiving hints that comprise an indication of anticipated relationships among files; and  
using the received hints to allocate storage for the files.

Accordingly, hints are received that comprise an indication of anticipated relationships among files, and the hints are used to allocate storage for the files. The Specification explains that such hints may be developed by "[c]ontent management systems [that] accumulate substantial information about expected use of a web site", where, for example, "within a web page, content management systems can infer which elements will tend to be viewed together." (Specification, page 11, lines 15-17).

Applicants appreciate the acknowledgement by the Final Office Action that Papierniak does not teach the recitation of "receiving hints that comprise an indication of anticipated relationships among files", which is recited in Claim 1. (Final Office Action, Page 3). Because Papierniak does not disclose "receiving hints", it also cannot teach "using the received hints to allocate storage for the files". The Office Action of May 20, 2004 also acknowledged on page 2 that Papierniak does not disclose "using ... received hints to allocate storage for ... files". Accordingly, Applicants submit that Papierniak does not teach either of the underlined recitations of Claim 1.

Applicants request reconsideration of the contention by the Final Office Action that Shoup teaches these missing recitations. The Final Office Action contends that Shoup on Page 2 at para. 0018, Page 3 at para. 0023, and Figs. 2 and 4 teaches "policies and their predicates for associating with files are [sic] the indication of anticipated relationships among files isxxx [sic] receiving hints that comprise an indication of anticipated relationships among files". (Final Office Action, Page 3, emphasis added).

The portions of Shoup relied upon by the Final Office Action appear to provide no such teaching. Applicants submit that the Final Office Action appears to have erroneously interpreted Shoup's description of "predicates" and their use to "facilitate correlation of a data file to a policy." (Shoup, Page 2 at para. 0020). Shoup discloses an "archiving system 22 [that] receives data files and performs a correlation operation prior to forwarding the data files to the storage portion of the system 23." (Shoup, Page 2 at para. 0017). The "predicates are employed to facilitate the correlation of a data file to a policy." (Shoup, Page 2 at para. 0020). Shoup discloses that the predicates can be "information about each data file such as original file name, submitting party information, creation date, expiration data, author, file format, size, and location in the archive storage 25." (Shoup, Pages 1-2 at Para. 0015). Shoup also discloses that "data files ... preferably fall within the scope of one or more policies". (Shoup, Page 2 at para 0019 and Page 3 at para 0023). However, Shoup is devoid of any teaching or suggestion that the predicates, policies, or any other portion of the archiving system 22 are hints that comprise an indication of anticipated relationships among files. Moreover, Shoup is devoid of any teaching or suggestion that hints of anticipated relationships among files can be received and used to allocate storage for the files.

Applicants also submit that it is improper to combine Papierniak with Shoup.

Applicants note that the Court of Appeals for the Federal Circuit has affirmed that to support combining references in a § 103 rejection, evidence of a suggestion, teaching, or motivation to combine must be *clear and particular*, and this requirement is not met by merely offering broad, conclusory statements about teachings of references. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In an even more recent decision, the Court of Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be particular evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55, USPQ2d 1313, 1317 (Fed. Cir. 2000).

Papierniak is directed to observing access patterns to "measure the effectiveness of the layout of a web site" by "observing consumers' behavior and analyzing consumers' decision

process over the Internet." (Papierniak, Col. 1, lines 44-49). In contrast, Shoup is directed to an archiving system. The only justification provided by the Final Office Action for combining Papierniak with Shoup is that the combination would "further [extend] the correlation of web page files with subject to other areas, such as attributes, file content and archiving policies because both references are devoted to file storage and archiving, the combined reference would have more efficiently managed file storage and retrieval, and more meaningfully presented files for business operation." (Final Office Action, Page 3). This justification does not appear to rise the required clear and particular suggestion, teaching, of motivation that must come from the references themselves, but instead appears to rely on impermissible hindsight to the application itself.

Applicants respectfully submit that the Final Office Action has not provided clear and particular support for why one who is skilled in the art would modify the teachings of Papierniak as to the measurement of web site layout effectiveness, based on observed access patterns, and the teachings of Shoup as to file archiving, to obtain the recitations of Claim 1.

However, as explained above, even if Papierniak is combined with Shoup, they would not teach or suggest receiving hints that comprise an indication of anticipated relationships among files, nor would they teach or suggest using the received hints to allocate storage for the files.

For at least these reasons Applicants submit that Claim 1 is patentable over Papierniak in view of Shoup.

Independent Claims 20 and 21 contain similar recitations to Claim 1, and are submitted to be patentable over Papierniak in view of Shoup for the reasons explained above for Claim 1.

Amended Independent Claims 3 and 6 contain similar recitations to Claim 1, and are submitted to be patentable over Papierniak in view of Shoup for the reasons explained above for Claim 1. Moreover, Claims 3 and 6 are submitted to provided further bases for patentability, as will be explained below.

Claim 3 recites that "the hints specify one or more files that are likely to be referenced within a temporal proximity of a reference to a selected one of the files." The Final Office Action erroneously contends that Shoup's teaching of "data file attributes [that] are examined

in accordance with policy predicates, [and] a correlation table [that] identifies policies that are associated with particular data files and file creation and expiration dates" are hints that specify one or more files that are likely to be referenced within a temporal proximity of a reference to a selected one of the files. However, Shoup is devoid of any teaching of a determination of what files are likely to be referenced within a temporal proximity of a reference to a selected file. Moreover, Shoup does not teach or suggest that hints can be generated that specify the determined likely temporal proximity of references to one or more files relative to a selected file. For at least these reasons, Claim 3 is submitted to be patentable over Papierniak in view of Shoup.

Claim 6 recites that the hints, which comprise an indication of anticipated relationships among files, are created by a content authoring tool, and that the hints specify one or more files that are likely to be referenced within a temporal proximity of a reference to a selected one of the files. As explained above, Shoup does not disclose or suggest hints that specify one or more files that are likely to be referenced within a temporal proximity of a reference to a selected one of the files. Moreover, Shoup discloses a file archiving system 22, not a content authoring tool. For at least these reasons, Claim 6 is submitted to be patentable over Papierniak in view of Shoup.

Dependent Claims 2, 4-5, and 7-19 are patentable as depending from allowable independent Claim 1. Moreover, at least dependent Claim 2 is submitted to provide further basis for patentability.

Claim 2 recites that the hints, which comprise an indication of anticipated relationships among files, are created by a content management system. In rejecting Claim 2, the Final Office Action erroneously contends that Shoup at Page 2 para. 0018 teaches that "hints are created by a content management system." (Final Office Action, Page 3). However, Shoup clearly discloses a file archiving system 22. It contains no teaching of a "content management system", and much less, does not teach or suggest a content management system that creates hints that comprise an indication of anticipated relationships among files. For at least these reasons, Claim 2 is submitted to be patentable over Papierniak in view of Shoup.

**CONCLUSION**

Applicants respectfully request entry of the present claim amendments as placing the claims in condition for allowance, or alternatively as placing the claims in better condition for appeal and narrowing the issues for further consideration on appeal. No new issues are raised by the present claim amendments. In light of the above amendments and remarks, Applicants respectfully submit that the above-entitled application is now in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (919) 854-1400.

Respectfully submitted,



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